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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,143	01/17/2002	Thomas Deyette JR.	1001.1475101	4732

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EXAMINER

DAWSON, GLENN K

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	<p>Application No.</p> <p>10/053,143</p>	<p>Applicant(s)</p> <p>DEYETTE ET AL.</p>	
	<p>Examiner</p> <p>Glenn K Dawson</p>	<p>Art Unit</p> <p>3731</p>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-13,21-30 and 34-42 is/are rejected.
- 7) ☒ Claim(s) 8,14-20,31-33 and 43-45 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>06-28-2002</u> . | 6) <input type="checkbox"/> Other: ____. |

Claim Objections

Claims 9,26 and 38 are objected to because of the following informalities: In claims 9 and 26, the use of actuation assembly" should be "actuator assembly" for consistency. In claim 38, the tubular member should be at the proximal end of the outer sheath, not the distal end. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 9-13,21-26 and 34-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Rosenbluth, et al.-6685722.

Rosenbluth discloses an outer sheath 650, inner shaft 680, distal protection device- 16, a manifold, see fig. 11 and an actuator 630,646. Sliding of the member 630 through the use of a gear and tooth arrangement causes movement of the outer tube relative to the inner shaft allowing the expansion and retraction of the member 16.

Claims 1-7 and 34-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Sisskind, et al.-6355051.

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Sisskind discloses an outer tube 12 and an inner shaft attached to a filter.

Movement of the thumb button 40 causes relative movement of the outer sheath relative to the inner shaft and allows for the opening and closing of the filter.

Claims 1-7 and 34-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Turovskiy, et al.-2002/0128679

Turovskiy discloses an outer tube 15 and an inner shaft attached to a filter 12.

Movement of the thumb button 5 causes relative movement of the outer sheath relative to the inner shaft and allows for the opening and closing of the filter.

Claims 1 and 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Makower, et al.-5324306.

Makower discloses an outer tube 76, an inner shaft 82, a distal protection device 80, a manifold 72, an actuator 84, 94 and a cover 118. Movement of the actuator causes relative movement of the outer tube relative to the inner shaft and causes the expulsion of the protection device.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 9-13,21-30 and 37-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sisskind-'051 in view of Makower, et al.-'306.

Sisskind discloses the invention as claimed with the exception of the type of actuator. Makower discloses an actuator for moving an inner shaft relative to an outer shaft. It would have been obvious to have used the actuators of Makower for actuating relative movement between the elements of Sisskind's device, as these actuators have been shown to be effective at moving two linear elements relative to each other.

Changing the elements which have the gear and the rack is considered an obvious design choice as being nothing more than an obvious rearranging of known parts.

Claims 9-13,21-30 and 37-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turovskiy-'679 in view of Makower, et al.-'306.

Turovskiy discloses the invention as claimed with the exception of the type of actuator. Makower discloses an actuator for moving an inner shaft relative to an outer shaft. It would have been obvious to have used the actuators of Makower for actuating relative movement between the elements of Torovskiy's device, as these actuators have been shown to be effective at moving two linear elements relative to each other.

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Changing the elements which have the gear and the rack is considered an obvious design choice as being nothing more than an obvious rearranging of known parts.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenbluth, et al.-'722 in view of Sisskind-'051.

Rosenbluth discloses the invention as claimed with the exception of the type of actuator. Sisskind discloses a button actuator. It would have been obvious to have changed the gear actuator to a button actuator, as taught by Sisskind, because Rosenbluth discloses that a variety of relative movement mechanisms can be used to move the elements relative to each other.

Allowable Subject Matter

Claims 8,14-20,31-33 and 43-45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn K Dawson whose telephone number is 703-308-4304. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on 703-308-2154. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Glenn K Dawson
Primary Examiner
Art Unit 3731

Gkd
27 December 2004